

REMARKS

At the outset, the Applicant wishes to express his appreciation to Patent Examiner Alan Diamond for the many courtesies extended to the undersigned attorney during the Personal Interview at the U.S.P.T.O. on December 16, 2004. The substance of this Personal Interview is set forth in the Examiner Interview Summary, and in this Amendment.

The amendments to this Patent Application are as follows. Each of the independent claims 1 to 8 has been amended in order to change the variable "a" from a range of "1 to 3" to the range of "2 or 3". In addition, the base oil was further limited to having a kinematic viscosity of 2 to 150 cSt at 100°C. During the Personal Interview, it was indicated that if this subject matter were added to each of the independent claims, that all the claims would appear to distinguish over the prior art of record.

Support for this subject matter added to each of these claims is found for the viscosity range on page 16 in lines 7 to 9 of the present Specification and on page 22 in lines 19 to 27 and on page 23 in lines 1 to 5 of the present Specification.

Support for having the variable "a" range from "2 to 3" can be found on page 8 in lines 11 to 17 of the present Specification as follows: "The pentaerythritol esters [I] are esters of

pentaerythritol, dipentaerythritol or tripentaerythritol and a monocarboxylic acid, and are ordinarily obtained by the reaction of pentaerythritol, dipentaerythritol, tripentaerythritol or a mixture thereof with a mixture of at least one carboxylic acid having the aforementioned alkyl group".

Also, support for having the variable "a" range from "2 to 3" is found in the Examples in the present Specification, wherein on page 26, Base Oil 4 comprises a hexaester of dipentaerythritol, and also on page 26, Base Oil 5 comprises a hexaester of dipentaerythritol, while on page 27, Base Oil 7 comprises an octaester of tripentaerythritol, and also on page 29, Base Oil 14 comprises an octaester of tripentaerythritol.

Hence, no new matter has been introduced by this amendment.

Reconsideration and withdrawal are respectfully requested for the rejection of claims 1-3 and 5 under 35 U.S.C. 103(a) as being unpatentable over *Williamitis* (U.S. Patent No. 2,807,155) in view of *Midgley, Jr. Et al* (Re. 19,265) and *Kohashi et al* (JP 62-292895).

Reconsideration and withdrawal are respectfully requested for the rejection of claims 4 and 6-8 under 35 U.S.C. 103(a) as being unpatentable over *Williamitis* in view of *Midgley, Jr. Et al.* and *Kohashi et al.* as applied to claims 1-3 and 5 above, and further in

view of JP 55-155093.

The *Williamitis* (U.S. Patent No. 2,807,155) discloses in column 1, in lines 30 to 36 providing a working fluid for a refrigeration apparatus which includes a lubricant comprising an organic acid ester of pentaerythritol and a refrigerant wherein the refrigerant is completely miscible with the ester and is capable of existing in liquid and gaseous phases within the operating temperature range of the refrigeration apparatus.

Williamitis, in column 2, in lines 23 to 29, discloses that the refrigerant used comprises a fluoro halo derivative of an aliphatic hydrocarbon of the character disclosed in the patent to Midgeley et al., Re. 19,265, reissued August 7, 1934, as for example, trichlorofluoromethane (Freon 11), dichlorodifluoromethane (Freon 12) and particularly difluoromonochloromethane (Freon 22).

Williamitis, in column 3, in lines 40 to 45, discloses that the lubricant can contain a mixture of different esters of the type described above selected so as to have a viscosity range from 50 to 2000 seconds Saybolt (SUS) measured as 100°F., the exact viscosity being dependent on the operating characteristics and the particular refrigerant of the refrigeration apparatus.

Thus, *Williamitis* fails to teach or to suggest the claimed

fluid composition, and the base oil having the claimed kinematic viscosity of 2 to 150 cSt at 100°C.

Also, the *Midgley Reissue Patent No. 19,265* as discussed above fails to teach or to suggest a fluid composition which consists of a chlorine-free fluorocarbon refrigerant and a refrigerator oil as a base oil which has a kinematic viscosity of 2 to 150 cSt at 100°C.

The *Kohoshi Japanese Publication No. 62-292895* discloses a refrigerating machine oil comprising a polyvalent alcohol ester and a glycidyl ester. Thus, *Kohoshi* fails to teach or to suggest a fluid composition for use in refrigerators, which consists of a chlorine-free fluorocarbon refrigerant and a refrigerator oil, and said refrigerator oil consists of a base oil which has a kinematic viscosity of 2 to 150 cSt at 100°C.

The *Japanese Patent No. 55-155-093* discloses a synthetic refrigerator oil having lubricating properties, prepared by adding trimethyl phosphate in a specific proportion to a neopentyl polyol ester.

Thus, this reference fails to teach or to suggest a fluid composition for use in refrigerators, which consists of a chlorine-free fluorocarbon refrigerant and a refrigerator oil, and said refrigerator oil consists of a base oil which has a kinematic

viscosity of 2 to 150 cSt at 100°C.

Also discussed during the Personal Interview were the Sasaki (U.S. Patent No. 6,582,621) and the published PCT Patent Application No. PCT/US90/02069 which was published as International Patent Application WO 90/12849, published November 1, 1990, based upon U.S. Patent Application Serial No. 343,087, filed April 25, 1989 in the United States. (This is the Jolley, U.S. Patent Application). At the present time, this published document WO 90/12849 is not available as prior art against the present U.S. Patent Application. Also, Sasaki is not prior art against the present U.S. Patent Application.

In summary, claims 1 to 8 have been amended, and are pending. In view of these amendments, it is firmly believed that the present invention, and all the claims, are patentable over all the prior art applied by the Patent Examiner under 35 U.S.C. 103. Withdrawal of

this ground of rejection is respectfully requested.

Respectfully submitted,

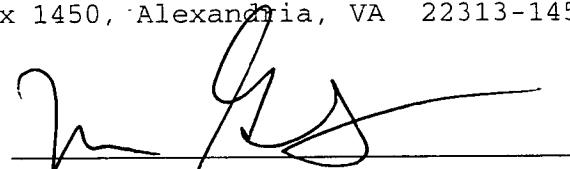
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on February 18, 2005.


Maria Guastella

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AUTHORIZATION TO ACT IN A REPRESENTATIVE CAPACITY

In re Application of: Hiroshi HASEGAWA	
Application No. 09/152,593	
Filed: September 14, 1998	
Title: Fluid composition containing refrigerator oils and chlorine-free fluorocarbon refrigerants	
Attorney Docket No.: BA-22624	Art Unit: 1753

The practitioner named below is authorized to conduct interviews and has the authority to bind the principal concerned. Furthermore, the practitioner is authorized to file correspondence in the above-identified application pursuant to 37 CFR 1.34:

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This is not a Power of Attorney to the above-named practitioner. Accordingly, the practitioner named above does **not** have authority to sign a request to change the correspondence address, a request for an express abandonment, a disclaimer, a power of attorney, or other document requiring the signature of the applicant, assignee of the entire interest or an attorney of record. If appropriate, a separate Power of Attorney to the above-named practitioner should be executed and filed in the United States Patent and Trademark Office.

SIGNATURE of Practitioner of Record

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